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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,803	03/07/2002	Krishnan Chari	83494D-W	3394

7590

05/03/2004

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,803

Applicant(s)

CHARI ET AL.

Examiner

Jennifer K Michener

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper 1/30/2004 is acknowledged. The traversal is on the ground(s) that the product must be made by the process of claim 1 and that since the product is tied to the process of manufacture, the search areas overlap, putting no burden on Examiner. This is not found persuasive because the art applied for the product may be different than that which would be applied for the method, the searches are different, and different issues arise during prosecution. Product claims are examined based on the properties of the final article produced, not on the method used to create the article. Further, the searches for the two classes are not necessarily the same. Examining both sets of claims would cause a burden on the Examiner based on the different issues that arise in examining method versus article claims. When examining a claim directed to a method of coating, it is necessary to find the process steps of the coating method. When examining claims directed to a coated product, the applicable art includes art directed to Applicant's final coated substrate produced by any method that would reasonably give that same product. Applicable art for a method of coating does not necessarily encompass all the fields of search required for product claims; and prior art used to reject the product claims would not necessarily contain the method steps of the coating process. Therefore there is an additional burden in examining two classes of invention.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claim 31 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guire et al. (US 2003/0073086 A1).

Examiner maintains the rejection.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guire in view of Nova (US 6,340,588 B1).

Examiner maintains the rejection.

Response to Arguments

6. Applicant's arguments filed 1/30/2004 have been fully considered but they are not persuasive.

Applicant argues that, Guire does not teach the method of Applicant, as amended, because Guire does not teach "thermal gelation", which Applicant argues occurs by "hydrogen bonding, not crosslinking", as required by Guire.

Examiner disagrees.

Examiner notes that the claim, as amended, requires only "coating... a receiving layer being capable of undergoing sol/gel transition by thermal gelation". This is not an active method step and requires only that the receiving layer be *capable* of undergoing sol/gel transition by thermal gelation. Because Applicant's specification states that gelatin, cellulose (both natural polymer proteins), and a type of acrylamide undergo a thermal type of gelation and because Guire teaches examples of acrylamides and natural polymeric proteins that under gelation, is Examiner's position that at least some of Guire's receiving layer polymers are inherently capable of sol/gel transition by thermal gelation since the polymers of Guire are the same or similar as Applicant's.

Additionally, Guire teaches that his receiving layer contains a thermally reactive group. Therefore, a process that goes through gelation, at least in some part, due to thermal energy, must undergo *thermal* gelation. Applicant argues that, despite the thermally reactive group, Guire's additional requirement for cross-linking is in direct contrast to Applicant's definition of thermal gelation which requires hydrogen bonding. Examiner notes that Applicant's discussion of thermal gelation as involving hydrogen bonding does not preclude other types of bonding and therefore, Guire's use of thermal energy to provide gelation will also contain the hydrogen-bonding required by Applicant.

Furthermore, Examiner notes that the independent claim contains a requirement that the substrate is also coated with a crosslinking agent. Therefore, just like Applicant, Examiner argues that Guire teaches a combination of thermal gelation, which involves hydrogen bonding, and gelation by crosslinking. Thermal gelation cannot preclude the

use of a crosslinking agent, as argued by Applicant, if the independent claim requires both thermal and crosslinking mechanisms to gel the receiving layer of Applicant.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

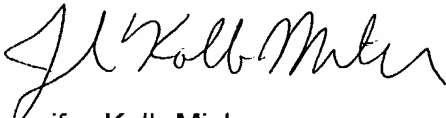
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer K Michener whose telephone number is (571) 272-1424. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Kolb Michener
Patent Examiner
Technology Center 1700
April 30, 2004